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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/592,960

01/02/2007

Jan Hendrik Lucas

820120-1020

3776

24504

7590

12/30/2008

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EXAMINER

DESANTO, MATTHEW F

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/592,960	<b>Applicant(s)</b> LUCAS ET AL.	
	<b>Examiner</b> MATTHEW F. DESANTO	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/13/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Robb (USPN 5,215,533).

3. Robb discloses a syringe with retractable injection needle, comprising a liquid container having a needle opening; a plunger/plunger rod assembly, which is moveable over a certain travel in the liquid container and comprises a plunger rod, plunger and a plunger head; an injection needle with needle mount which, in an active position, projects out of the liquid container through the needle opening and, in a retracted position, is located fully within the liquid container; a travel limiter which comes into action after an injection has been administered using the injection syringe and subsequently the injection needle with needle mount has been moved into the retracted position by the plunger/plunger rod assembly being retracted, after which it restricts the plunger/plunger rod assembly in the event of a movement towards the needle opening, in such a manner that the injection needle cannot be pushed out of the liquid container,

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wherein the travel limiter comprises a stop mechanism having a stop face associated with the plunger/plunger rod assembly, and having a stop face associated with the liquid container, it being possible for at least one stop face to be displaced between an initial, inactive position, in which an injection can be administered using the injection syringe, and an active position, in which the stop faces actively come into contact with one another and thereby limit the travel of the plunger/plunger rod assembly (figure 3 and entire reference).

4. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarthy (USPN 4,995,869).

5. McCarthy discloses a syringe with retractable injection needle, comprising a liquid container having a needle opening; a plunger/plunger rod assembly, which is moveable over a certain travel in the liquid container and comprises a plunger rod, plunger and a plunger head; an injection needle with needle mount which, in an active position, projects out of the liquid container through the needle opening and, in a retracted position, is located fully within the liquid container; a travel limiter which comes into action after an injection has been administered using the injection syringe and subsequently the injection needle with needle mount has been moved into the retracted position by the plunger/plunger rod assembly being retracted, after which it restricts the plunger/plunger rod assembly in the event of a movement towards the needle opening, in such a manner that the injection needle cannot be pushed out of the liquid container, wherein the travel limiter comprises a stop mechanism having a stop face associated with the plunger/plunger rod assembly, and having a stop face associated with the liquid

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container, it being possible for at least one stop face to be displaced between an initial, inactive position, in which an injection can be administered using the injection syringe, and an active position, in which the stop faces actively come into contact with one another and thereby limit the travel of the plunger/plunger rod assembly (figure 1-3 and entire reference).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. If you would like assistance from a USPTO Customer Service Representative call 800-786-9199 or 571-272-1000.

Matthew DeSanto  
/Matthew F DeSanto/  
Primary Examiner, Art Unit 3763